REMARKS

In response to the Office Action dated June 8, 2009, Applicants respectfully request reconsideration of the rejections of the claims.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16 - 19, and 22 - 26 are rejected under 35 U.S.C. § 103, on the basis of the *Farrell* and *Trovinger* (US 6,873,426 and US 6,708,967, respectively). However, since there is no description of this rejection, Applicants assume that the rejection is in error and should be withdrawn.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16 - 19, and 22 - 26 are rejected under 35 U.S.C. § 102(e), on the basis of the *Farrell*. Claims 3, 6, 9, 12, 15, and 20 were rejected on the basis of *Farrell* in view of *Jeyachandran* (US 6,567,176). Claim 21 was rejected on the basis of *Farrell* in view of *Jeyachandran* and *Trovinger* (US 6,708,967).

For the reasons discussed hereinafter, it is respectfully submitted that these references do not teach or suggest the claimed subject matter to a person of ordinary skill in the art, whether considered individually or in combination.

The claimed subject matter has been summarized in several previous responses, and it is assumed that the Examiner is familiar with the summaries and arguments made in the previous responses.

Claim 1 recites, among other elements, a printing system having an on-line client, a print server and printer, and an off-line finishing device. As is clear from the remainder of the claim, as well as the specification, the off-line finishing device is a finishing device that is capable of functioning, but which is located separately from the printer.

The claim further recites that the print server includes a first memory for storing specifications of the on-line printer and of the off-line finishing device, as well as information regarding options installed thereon. Claim 1 further recites that the printing system includes a sorter for separating finishing specifics included in a job ticket into those to be performed by the on-line printer and *those to be performed by the off-line finishing device*, based on the information regarding the specifications and installed options that is stored in the first memory.

The Examiner alleges that such features are taught by *Farrell*. However, it is clear from *Farrell* that the term "off-line" is used differently. It is clear that when *Farrell* refers to the finishing device 18 as being "off-line" it is meant that the finishing device 18 is down and not operating. See column 4, lines 10 - 11, "or is otherwise unavailable". Furthermore, this position is confirmed by the flow chart of Figure 3, which proceeds to blocks 50, 52 (for finishing with alternate instructions) only after it is determined that the finishing *cannot* be completed with the provided instructions. See block 44 in Figure 3.

In contrast to the usage in *Farrell*, the present application clearly defines what is meant by off-line. "…'off-line' means that the device is not connected to any of the other devices of the printing system via either route [i.e., locally or via a network]." See paragraph [0032] of the published application US 2002/0042798.

As set forth in claim 1, the claimed sorter bases the separating on the specifications and installed options that *can be performed* by the finishing device. Accordingly, *Farrell* cannot teach such separating based on specifications and installed options that can be performed by the finishing device18 since, as is clear

from block 44 in Figure 3, the specifications referred to in blocks 50, 52 are not specifications that can be performed by the finisher 18.

In addition, *Farrell* teaches that the finishing options are to be performed by the finishing device 18. Thus finisher 18 is the only structure in *Farrell* that is capable of performing finishing. In contrast, claim 1 recites that the printing system includes a sorter for separating finishing specifics included in a job ticket into those **to be performed by the on-line printer** and **those to be performed by the off-line finishing device**. Thus, the claim requires that there are two finishing devices - one that is on-line with the print server and connected to the printer and the other that is off-line. *Farrell* does not teach separating finishing instructions in to those that can be accomplished by two different units.

In the prior response, it was argued that the *Farrell* patent does not disclose a printing system that stores information about an on-line printer <u>and</u> a distinct, i.e., off-line, finishing device, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus, the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9 - 22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

Accordingly, *Farrell* does not teach or suggest claim 1.

Claims 2 - 15 are patentable at least for reasons similar to those set forth above.

Claim 16 recites a print server to be used in a printing system including a client, the print server, a printer on which at least one finishing option is installed, and a finishing device that is separately provided from the printer. The print server comprises a first memory section that stores information on the specifications of the printer, the finisher, and the at least one finishing option installed on the printer; and a control section that separates the finishing specifics included in the job ticket received by the receiving section into a first group of finishing specifics to be performed by the **at least one finishing option installed on the printer** and a second group of **finishing specifics to be performed by the finishing device** separately provided from the printer.

The Examiner alleges that such features are taught by *Farrell*. As set forth in claim 16, the claimed control section separates the finishing specifics included in the job ticket into a first group of finishing specifics to be performed by the **at least one finishing option installed on the printer** and a second group of **finishing specifics to be performed by the finishing device** separately provided from the printer.

Accordingly, *Farrell* cannot teach such separating based on specifications and installed options that can be performed by the finishing device18 since, as is clear from block 44 in Figure 3, the specifications referred to in blocks 50, 52 are not specifications that can be performed by the finisher 18.

In addition, *Farrell* teaches that the finishing options are to be performed by the finishing device 18. Thus finisher 18 is the only structure in *Farrell* that is capable of

performing finishing. In contrast, claim 16 recites that **at least one finishing option is installed on the printer** and a second group of **finishing specifics to be performed by the finishing device** separately provided from the printer.

Thus, the claim requires that there are two finishing devices - one that is installed on the printer and the other that is provided separately. *Farrell* does not teach separating finishing instructions in to those that can be accomplished by two different units.

In the prior response, it was argued that the *Farrell* patent does not disclose a printing system that stores information about an on-line printer <u>and</u> a distinct finishing device that is provided separartely, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus, the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9 - 22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

Accordingly, *Farrell* does not teach or suggest claim 16. Claims 17 - 26 are patentable for similar reasons.

Claims 3, 6, 9, 12, 15, 20, and 21 are rejected under 35 USC 103(a) as being allegedly unpatentable over *Farrell* in combination with U.S. patent No. 6,567,176, hereinafter *Jeyachandran.* For claim 21, U.S. Patent No. 6,708,967, hereinafter

Trovinger is also used. However, the features relied upon from *Jeyachandran* do not overcome the deficiencies set forth above with regard to *Farrell*.

With regard to *Trovinger*, the Examiner alleges that the finishing device is an off-line device. However, that also does not overcome the fact that *Farrell* does not teach or suggest the two different devices for finishing. Accordingly, neither *Jeyachandran* nor *Trovinger* overcome the deficiencies of *Farrell* that are outlined above.

New claim 27 further recites that wherein the on-line printer is capable of performing finishing procedures and the off-line finishing device is not connected to the on-line printer or the on-line print server. Support for the claim is found in paragraphs [0033] and [0037].

The applied prior art does not teach the new claims at least for the reasons set forth above.

Other distinguishing features of the invention are set forth in the dependent claims. In view of the fundamental difference identified above, a further discussion of these additional distinctions is believed to be unnecessary at this time.

For the foregoing reasons, it is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Applicants respectfully request reconsideration and withdrawal of the rejections, and allowance of all pending claims.

Respectfully submitted,

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